

REMARKS

This Amendment is being filed with a Request for Continued Examination (RCE), and is responsive to the final Office Action dated April 3, 2006. This Amendment constitutes the required submission with the RCE. A Notice of Appeal was submitted on June 29, 2005. The filing of this RCE reopens prosecution. In this Amendment, Applicants have amended claims 49, 57 and 65, and canceled claims 50, 51, 58, 59, 66 and 67. New claim 73 has been added. Claims 1-49, 52-57, 60-65 and 68-73 are now pending.

As a preliminary matter, Applicants note that the final Office Action mischaracterizes Applicants' arguments to date. For example, in the "Response to Arguments" section, the final Office Action states that Applicants argue that the Granstam reference (US 6,587,691 B1) fails to disclose or suggest supplying power to the SIM when a request is pending for service by the SIM, supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM, and terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM, as required by claims 1, 17 and 33. The final Office Action then states that Granstam was not cited as disclosing these features that Applicants argued as being lacking from Granstam..

However, contrary to the comments advanced in the final Office Action, Applicants have specifically recognized that that the Granstam is not being cited as disclosing the features listed above. Moreover, in the previous response, Applicants explained that, contrary to the analysis in the Office Actions to date, the Koilpillai reference (US 6,678,508 B1) fails to suggest supplying power to the SIM when a request is pending for service by the SIM, supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM, and terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM as required by claims 1, 17 and 33. Therefore, even if Granstam were modified to incorporate the features of Koilipilar, the result would not conform to features required by Applicants' claims. These arguments are explained in greater detail below.

Indeed, the current analysis is very suspect insofar as the Granstam reference is cited as teaching merely the preamble of Applicants claims. The final Office Action lists every feature in the body of claims 1, 17 and 33 as not being taught by the primary Granstam reference. The

final Office Action attributes these features, however, to Koipillai and concludes that a person of ordinary skill in the art would have modified the teaching of Granstam in view of Koipillai to arrive at Applicants' claimed invention. As outlined in detail below, however, the final Office Action misinterprets the Koipillai reference, as this reference lacks any teaching of the features attributed to this reference by the final Office Action.

Applicants are also confused by the comments in the final Office Action that:

The examiner asserts that the combination of Granstam and Koipillai was used to teach powering a SIM and terminating power to a SIM during operation of the WCD, much less the specific contingencies required by claims 1, 17 and 33 when power is supplied to the SIM.

In this statement, the final Office Action appears to be rejecting the claims, yet acknowledging that the specific contingencies required by claims 1, 17 and 33 are not disclosed in either Granstam and Koipillai. Indeed, neither Granstam nor Koipillai discloses supplying power to the SIM when a request is pending for service by the SIM, supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM, and terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM, as required by claims 1, 17 and 33.

Furthermore, the analysis in the final Office Action is flawed insofar as the analysis plucks disparate unrelated features from the prior art teaching to reconstruct Applicants' claimed invention using a hindsight-based analysis. Of course, such a hindsight-based reconstruction of the invention is forbidden to support a conclusion of obviousness. The correct analysis requires the Examiner to show that the features of Applicants' claims are disclosed in the prior art, and that a person of ordinary skill in the art (at the time of Applicants' invention) would have been motivated to combine such features to arrive at Applicants' claimed invention. The final Office Action demonstrates neither of these requirements of a *prima facie* case of obviousness.

Applicants also respectively note that a number of typographical discrepancies exist in the final Office Action, which make the final Office Action very difficult to follow. As one example, on page 8 the final Office Action cites Deschepper et al. as US Patent 6,741,848. However, US Patent 6,741,848 was awarded to Timonen et al., not Deschepper et al. Applicants have noted this same discrepancy in the previous *three* responses, and are perplexed as to why this discrepancy remains in the current Office Action.

As another example, on page 3, the final Office Action claims 49, 57 and 65 are listed as being anticipated by Leickel et al. (US 6,696,919 B1) (“Leickel”). However, the final Office Action provides no analysis of the Leickel reference for the anticipation rejection, and refers instead to irrelevant passages of Granstam. Accordingly, it is unclear whether the anticipation rejections of claims 49, 57 and 65 rely on Granstam or Leickel. For purposes of this response, Applicants have made a good faith effort to review all of the references and respond accordingly.

Claims 1, 17 and 33

Claims 1, 17 and 33 require the supply of power or the termination of power to a SIM based on whether a request is pending for service by the SIM or the device requests maintenance of power to the SIM. In this manner, the power management techniques recited in Applicants’ claims 1, 17 and 33 permit power conservation within a wireless communication device (WCD) without undermining SIM performance. In accordance with claims 1, 17 and 33, power is terminated to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM.

Furthermore, claims 1, 17 and 33 require management of power to a subscriber identity module (SIM) in a wireless communication device (WCD) when power is supplied to the WCD during operation of the WCD. Thus, the power management features of claims 1, 17 and 33 apply when power is supplied to the WCD, and are distinguished from any conventional sleep mode techniques in which power to the WCD is disabled.

The final Office Action cites Granstam as disclosing the control of power to a SIM. The Office Action recognizes that Granstam fails to disclose or suggest supplying power to the SIM when a request is pending for service by the SIM, or supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM, or terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM. Hence, the final Office Action acknowledges that Granstam fails to disclose virtually every feature of the claimed invention. For this reason, it is unclear why Granstam was even cited. Nevertheless, the final Office Action construes Koilpillai as disclosing the features lacking from Granstam, and concludes that a person of ordinary skill in the art would have been motivated to modify the techniques taught in Granstam with those of Koilpillai to arrive at Applicants’ claimed invention.

Several errors remain in the analysis of the final Office Action. Many of the errors have been explained previously by Applicants, yet continue to be ignored in the final Office Action. First, contrary to the conclusions advanced in the final Office Action, Granstam does not disclose power management techniques applicable to a SIM. The cited passages of Granstam, for example, appear to teach nothing more than the fact that SIMs were known in the art. Applicants' claims are not so broad as to cover a conventional SIM, but rather require a power management technique that provides power to the SIM and terminates power to the SIM based on specific contingencies recited in the claims. None of the applied references disclose or suggest the specific power management techniques recited in claims 1, 17 and 33.

Second, the Koilpillai reference does not teach anything with respect to SIMs, whatsoever, much less the power management techniques attributed to this reference by the final Office Action. Instead, Koilpillai describes conventional power conservation techniques in which a WCD (not a SIM) is put into a sleep mode. As described in Koilpillai, the WCD cycles in and out of sleep mode when it is not involved in a call. In sleep mode, the receivers and transmitters of Koilpillai are disabled.

The obviousness analysis of the final Office Action appears to rely on observations that Granstam teaches the use of SIMs, and Koilpillai teaches a sleep mode algorithm for a WCD. Apparently, the final Office Action is concluding that these teachings would have led a person of ordinary skill in the art to modify a WCD that includes a SIM to provide some type of sleep mode applicable to the SIM. Based on this, the final Office Action appears to have concluded that the features of claims 1, 17 and 33 would have been obvious to a person of ordinary skill in the art in view of the combined teachings of Granstam and Koilpillai.

Contrary to Applicants' claims, however, Koilpillai teaches a sleep mode algorithm for a WCD in which receivers and transmitters are disabled, and not a technique for terminating power to a SIM when power is supplied to the WCD. Indeed, Koilpillai is completely silent with respect to SIMs, and does not disclose or suggest any sleep mode techniques applicable to the SIM when power is supplied to the WCD. Therefore, contrary to the analysis in the final Office Action, Koilpillai fails to suggest the features recited in claims 1, 17 and 33. In particular, Koilpillai does not suggest powering a SIM and terminating power to the SIM during operation of the WCD, much less the specific contingencies required by claims 1, 17 and 33 when power is

supplied to the WCD. The statements in the final Office Action that Koilpillai discloses these features are plainly incorrect, and reflect clear misinterpretations of the Koilpillai reference.

In short, contrary to the analysis in the final Office Action, Koilpillai fails to suggest supplying power to the SIM when a request is pending for service by the SIM, supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM, and terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM as required by claims 1, 17 and 33. The Examiner cited no teaching in Koilpillai that conforms to such features. Therefore, even if Granstam were modified to incorporate the features of Koilipilar, the result would not conform to features required by Applicants' claims.

Moreover, the pending claims require managing power to a SIM in a WCD when power is supplied to the WCD during operation of the WCD. These features also distinguish Koilpillai and Granstam. Granstam does not disclose power management techniques applicable to a SIM, whatsoever, and the cited passages of Granstam appear to teach nothing more than the fact that SIMs were known. Koilpillai describes sleep cycles in which power to the WCD is disabled. However, the claimed techniques concern management of power to the SIM when power is supplied to the WCD during operation of the WCD, and not power management of the WCD receivers and transmitters to disable operation of the WCD in sleep mode, as taught by Koilpillai.

For the many reasons outlined above, the final Office Action has fails to establish a prima facie case of obviousness with respect to claims 1, 17 and 33. Applicants reserve further comment with respect to the various dependent claims to claims 1, 17 and 33 not addressed herein, but do not acquiesce to the final Office Action's rejections of the claims, nor the final Office Action's characterizations of the prior art relative to these claims. Therefore, Applicants reserve the right to present additional arguments with respect to on or more of the dependent claims.

Claims 49, 57 and 65

In the final Office Action, the Examiner rejected claims 49, 57 and 65 under 35 U.S.C. 102(b) as being anticipated by Leickel et al. (US 6,696,919 B1) ("Leickel"). However, the Examiner provided no analysis of the Leickel reference. The entire analysis of the rejection of

claims 49, 57 and 65 under 35 U.S.C. 102(b) as being anticipated by Leickel refers to irrelevant passages of Granstam.

Nevertheless, Applicants have amended claims 49, 57 and 65 to recite features similar to claims 1, 17 and 33 addressed above. The features added to claims 49, 57 and 65 were formerly recited in dependent claims, which were not subject to the anticipation rejections in view of Leickel. Accordingly, the anticipation rejections based on Leickel have been overcome. The features of amended claims 49, 57 and 65 also clearly distinguish Granstam. Therefore, to the extent an anticipation rejection based on Granstam may have been intended, amended claims 49, 57 and 65 also clearly overcome such a rejection.

In the current Amendment, the features of claims 50 and 51 have been added to claim 49, the features of claims 58 and 59 have been added to claim 57 and the features of claims 66 and 67 have been added to claim 65. The final Office Action rejected former claims 50-53, 56, 58-61, 64, 66-69 and 72 under 35 U.S.C. 103(a) as being unpatentable over Leickel in view of Koipillai. However, these rejections are flawed for at least two fundamental reasons.

First, the Koipillai reference does not disclose or suggest the features attributed to it in the final Office Action, which were formerly recited in claims 50, 58 and 66. In particular, as outlined above, Koipillai does not disclose or suggest supplying power to the SIM when a request is pending for service by the SIM, supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM, and terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM. Second, contrary to the analysis in the final Office Action, Leickel fails to disclose or suggest the features formerly recited in claims 51, 59 and 67.

With regard to the features formerly recited in claims 50, 58 and 66, the final Office Action applies similar rejections to those of claims 1, 17 and 33, but uses Leickel as the primary reference rather than Granstam. The final Office Action states that Koipillai teaches supplying power to the SIM when a request is pending for service by the SIM, supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM, and terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM. The final

Office Action concluded that a person of ordinary skill in the art would have modified the system of Leickel in view of Koilpillai to arrive at the features of claims 50, 58 and 66.

As outlined in detail above, however, Koilpillai does not disclose or suggest supplying power to the SIM when a request is pending for service by the SIM, supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM, and terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM. Again, Koilpillai teaches a sleep mode algorithm for a WCD in which receivers and transmitters are disabled, and not a technique for terminating power to a SIM when power is supplied to the WCD. Indeed, Koilpillai is completely silent with respect to SIMs, and does not disclose or suggest any sleep mode techniques applicable to the SIM when power is supplied to the WCD.

Therefore, contrary to the analysis in the final Office Action, Koilpillai fails to suggest the features formerly recited in claims 50, 58 and 66, and currently recited in amended claims 49, 57 and 65. In particular, Koilpillai does not suggest powering a SIM and terminating power to the SIM during operation of the WCD, much less the specific contingencies required by claims 49, 57 and 65 when power is supplied to the WCD. Consequently, even if the system of Leickel were modified to incorporate the features of Koilpillai, the result would not conform to features required by Applicants' claims.

With regard to the features formerly recited in claims 51, 59 and 67 (which are also now recited in independent claims 49, 57 and 65), the final Office Action relies upon Leickel. In particular, the final Office Action states that Leickel teaches retrieving and using the user access code when power is resupplied to the SIM following termination of power to the SIM when no request from the WCD is pending for service by the SIM and no software module running on the WCD requests supply of power to the SIM, and accepting and using user input as the user access code when power is resupplied to the SIM following termination of power to the SIM when power to the WCD is terminated.

Unfortunately, the cited passages of Leickel do not teach anything akin to these features attributed to this reference by the final Office Action. The cited passage of Leickel (column 5, line 40 to column 6, line 27) describes a technique in which a PIN for a mobile telephone is stored in a automobile key or a remote control for the automobile. The PIN is read when the key or the remote control is activated, and the PIN is then stored to allow user access to the mobile

telephone. If the PIN memory is still empty when the automobile is operated, the user has an opportunity to activate an automatic PIN by once manually entering the PIN.

Nothing in this cited passage of Leickel suggests retrieving and using the user access code when power is resupplied to the SIM following termination of power to the SIM when no request from the WCD is pending for service by the SIM and no software module running on the WCD requests supply of power to the SIM. Furthermore, nothing in this cited passage of Leickel suggests accepting and using user input as the user access code when power is resupplied to the SIM following termination of power to the SIM when power to the WCD is terminated. Applicants claims 49, 57 and 65 specifically require use of a stored access code following termination of power to the SIM when no request from the WCD is pending for service by the SIM and no software module running on the WCD requests supply of power to the SIM, and also specifically require use of user input as the user access code when power is resupplied to the SIM following termination of power to the SIM when power to the WCD is terminated. This combination of requirements are simply lacking from cited passages of Leickel.

For at least the reasons outlined above, Applicants submit that the final Office Action has failed to establish a prima facie case of obviousness with respect to amended claims 49, 57 and 65. Applicants reserve further comment with respect to the various dependent claims to claims 49, 57 and 65 not addressed herein, but do not acquiesce to the Office Action's rejections of the claims, nor the Office Action's characterizations of the prior art relative to these claims. Therefore, Applicants reserve the right to present additional arguments with respect to on or more of the dependent claims.

Dependent claims

Various dependent claims stand rejected based on the flawed obviousness analyses addressed above. In addition, several dependent claims stand rejected in view of the obviousness analyses addressed above, and additional references, such as Timonen et al. (US Patent 6,741,848 and Eber et al. (US Patent 6,595,414). These secondary references were not cited for the features of the independent claims addressed above, and provide no teaching that would overcome the several deficiencies addressed above in relation to the independent claims. Applicants reserve further comment on the Timonen and Eber references at this time.

Conclusion

In view of the comments above and the amendments to independent claims 49, 57 and 65, all claims in this application are clearly allowable over the current prior art being applied in the final Office Action. Accordingly, Applicants respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 17-0026. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

By:

9/7/06
QUALCOMM, Inc.
5775 Morehouse Drive
San Diego, CA 92121
Telephone: (858) 651-1306
Facsimile: (858) 658-2502

/ /George C. Pappas /
/Darla Kasmedo/
Name: George Pappas
Reg. No.: 35,065